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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 09/301,043      | 04/28/99    | COOK                 | C 14090/40006       |

Q002/0705  
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EXAMINER

RIVELL, J

| ART UNIT | PAPER NUMBER |
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3753

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

09/301,043

Applicant(s)

COOK ET AL.

Examiner

John Rivell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- 1) ☒ Responsive to communication(s) filed on 5/22/00 (election).
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 20-34 is/are pending in the application.
- 4a) Of the above claim(s) 31-34 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-17 is/are allowed.
- 6) ☒ Claim(s) 1-8, 20-24 and 27-29 is/are rejected.
- 7) ☒ Claim(s) 9, 25, 26 and 30 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
- 1. ☐ received.
  - 2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
  - 3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

### Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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Upon further review of this application it is noted that there are no claims numbered 18 and 19. Thus claims 1-17 and 20-34 are pending.

Applicant's election with traverse of the invention of Group I, claims 1-17 and 20-30 in Paper No. 4, filed May 22, 2000 is acknowledged. The traversal is on the ground(s) that applicant believes that the claimed apparatus would be difficult to produce in a blow molding process. To the extent this argument applies to a blow molding process the argument is found persuasive. However, upon review of the prior art it is believed that the product as claimed can be made by another materially different process such as by forming the "annular collar" separately from the remainder of the basin and later attached by fusion welding, inductive welding or by mechanical means such as by adhesives as set forth in the cited reference to Sleasman et al. It should be noted that the manufacturing step (i.e. "integrally molded") in the apparatus claim does not merit patentable weight<sup>1</sup>.

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<sup>1</sup>M.P.E.P. §2113 Product by Process Claims [ R-1 ] >PRODUCT-BY-PROCESS CLAIMS ARE NOT LIMITED TO THE MANIPULATIONS OF THE RECITED STEPS, ONLY THE STRUCTURE IMPLIED BY THE STEPS

"Even though product-by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted) (Claim was directed to a novolac color developer. The process of making the developer was allowed. The difference between the inventive process and the prior art was the addition of metal oxide and carboxylic acid as separate ingredients instead of adding the more expensive pre-reacted metal carboxylate. The product-by-process claim was rejected because the end product, in both the prior art and the allowed process, ends up containing metal carboxylate. The fact that the metal carboxylate is not directly added, but is instead produced in-situ does not change the end product.).

ONCE A PRODUCT APPEARING TO BE SUBSTANTIALLY IDENTICAL IS FOUND AND A 35 U.S.C. 102 / 103 REJECTION MADE, THE BURDEN SHIFTS TO THE APPLICANT TO SHOW AN UNOBLVIOUS DIFFERENCE

"The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. In re Fessman, 180 USPQ 324, 326 (CCPA 1974). Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 218 USPQ 289, 292 (Fed. Cir. 1983) (The claims were directed to a zeolite manufactured by mixing together various inorganic materials in solution and heating the resultant gel to form a crystalline metal silicate essentially free of alkali metal. The prior art described a process of making a zeolite which, after ion exchange to remove alkali metal, appeared to be "essentially free of alkali metal." The court upheld the rejection because the applicant had not come forward with any evidence that the prior art was not "essentially free of alkali metal" and therefore a different and unobvious product.).

Ex parte Gray, 10 USPQ2d 1922 (Bd. Pat. App. & Inter. 1989) (The prior art disclosed human nerve growth factor (-NGF) isolated from human placental tissue. The claim was directed to -NGF produced through genetic engineering techniques. The factor produced seemed to be substantially the same whether isolated from tissue or produced through genetic engineering. While the applicant questioned the purity of the prior art factor, no concrete evidence of an unobvious difference was presented. The Board stated that the dispositive issue is whether the claimed factor exhibits any unexpected properties compared with the factor disclosed by the prior art. The Board further stated that the applicant should have made some comparison between the two factors to establish unexpected properties since the materials appeared to be identical or only slightly different.).

The requirement is still deemed proper and is therefore made FINAL.

Claims 31-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 4.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 6 are rejected under 35 U.S.C. 102 (b) as being anticipated by Sleasman et al. In Sleasman et al. there is disclosed a plastics sewerage basin including a cylindrical wall at 52 having an open top closed by lid assembly 22 and a closed bottom at wall 31. Lower end includes an "annular collar" read at 15 which when "welded" as disclosed to the lower section is "integral" "Molded" is clearly a manufacturing step<sup>1</sup>. The lower conical "annular collar" when attached by welding "projects from the outer wall surface adjacent the closed bottom". An inlet opening is shown at 20. "A nub" is read at pipe section 66. "Annular ribs" are read at the corrugations 54.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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THE USE OF 35 U.S.C. 102 / 103 REJECTIONS FOR PRODUCT-BY-PROCESS CLAIMS HAS BEEN APPROVED BY THE COURTS

"[T]he lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sleasman et al. The patent to Sleasman et al. discloses the claimed features with the exception of having the lower section wall generally downwardly tapered and the upper section upwardly tapered. However, to employ tapered walls as recited in the locations cited in Sleasman et al. is considered to be an obvious design expedient over these features as disclosed in Sleasman et al. relating to the desired shape of the basin which provide no new and/or unexpected results nor solves any stated problem.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sleasman et al. in view of Sidaway et al. The patent to Sleasman et al. discloses all the claimed features with the exception of having the "nub" extend from a flat surface of the basin. The patent to Sidaway et al. discloses that it is known in the art to employ a flat surface at 32 from which extends "nub" or pipe section 36 for the purpose of providing proper structural support for the extending pipe section. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ in Sleasman et al. a flat surface at gasket 27 from which "nub" 66 extends for the purpose

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of providing proper structural support for the extending pipe section as recognized by Sidaway et al.

Claims 20-24, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sleasman et al. in view of Hoffman. The patent to Sleasman et al. discloses all the claimed features with the exception of having an annular flat upper surface inside of which fits the upper lid assembly 22. The patent to Hoffman discloses that it is known in the art to employ an annular upper surface 38 inside of which an attached lid or cover for the purpose of providing a flush fit of the cover and the upper section of the sewer basin. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ in Sleasman et al. an upper annular surface into which fits the upper lid or cover assembly 22 for the purpose of providing a flush fit of the cover to the basin as recognized by Hoffman.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sleasman et al. in view of Hoffman as applied to claims 20-24, 27 and 28 above, further in view of Sidaway et al. as applied to claim 5 above.

Claims 10-17 are allowed.

Claims 9, 25, 26 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Rivell whose telephone number is (703) 308-2599. The examiner can normally be reached on Mon.-Thur. from 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (703) 308-2580. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7765 for regular communications and (703) 308-7765 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.

j.r.  
07/02/00

  
John Rivell  
Primary Examiner  
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